

REMARKS/ARGUMENTS

The Office Action mailed October 6, 2003 has been reviewed and carefully considered. In the present amendment, all of the pending claims (Claims 1-20) have been amended in order to conform with U.S. patent practice (including the deletion of reference numerals to thereby emphasize that the claims are in no way limited to the embodiments shown in the drawings), as well as to clarify the nature of the present invention. The specification has also been amended to conform with U.S. patent practice (e.g., by adding appropriate headings) and to add appropriate reference numerals to two paragraphs on page 10 (describing FIGS. 6 and 7). In addition, the specification now recites the priority claim which has already been submitted to, and acknowledged by, the U.S. Patent and Trademark Office (see Notification of Acceptance of Application under 35 U.S.C. 371 (PTO Form PCT/DO/EO/903) dated April 10, 2001, or the Filing Receipt dated April 11, 2001).

None of the claim amendments constitute new matter.

The phrase "subscriber data" now being used in amended independent Claims 1 and 13 is found in the originally filed specification at least at lines 7-16 of page 4 (*see, e.g.,* lines 11-12: "... ...the subscriber data corresponding to the subscriber apparatus...") and lines 6-24 on page 6 (*see, e.g.,* lines 6-8: "... to provide a database by means of which a subscriber apparatus connected to the network can be advantageously identified"). The phrase "wherein the network element associates the subscriber apparatus of the user with a mobile communications means of the user on the host mobile network" in amended Claims 1 and 13 is supported by the originally filed specification in its entirety, and more specifically, by lines 7-16 on page 4, lines 6-12 on page 6, and lines 33-36 on page 7.

Both of the "emulating" steps in Claim 1 originally referred to "a desired interface", making it somewhat unclear as to whether the same interface was being referred to in both emulating steps. Although both steps may, in some embodiments, refer to the same interface, the present Amendment separates them into a "first desired interface" and "a second desired interface", as they are conceptually different. To provide a concrete example of the reasoning here, consider FIGS. 6 and 7 of the present application. Although network element 11 emulates a radio interface 95b towards the host network 90 (i.e., "the first desired interface" of amended

Claim 1), network element 11 also emulates another interface, consisting of the wired lines of a fixed telephone network, towards subscriber apparatus 21 (i.e., "the second desired interface" of amended Claim 1).

Reconsideration and withdrawal of the objections and rejections in the October 6, 2003 Office Action are requested on the basis of the foregoing amendments and the following remarks.

In the Office Action dated October 6, 2003, the following issues were raised:

- I. An abstract on a second sheet was required;
- II. Guidelines for arranging the specification were suggested;
- III. Corrected drawings were required;
- IV. A "group of patents" were placed in the application file, but not considered;
- V. Claims 19 and 20 were objected to as having improper antecedent basis; and
- VI. Independent Claims 1 and 13, as well as Claims 2-12 and 14-20 depending therefrom, were rejected under 35 U.S.C. §103(a) as unpatentable over *Widegren et al.* (WO 97/34437; hereinafter *Widegren*) in view of *Veloso* (US 6,122,508; hereinafter *Veloso*).

I. Abstract on Separate Sheet Required

The Examiner required under 37 CFR §1.72(b) that an Abstract on a separate sheet be filed. Applicant notes that this an improper objection, because the present application is a U.S. national stage application of international stage PCT application No. PCT/FI99/00562, the pamphlet of which was included in the filing papers of this national stage application. As stated at §1893.03(e) of the MPEP (emphasis added):

When the international application is published as the pamphlet, the abstract is reproduced on the cover page of the publication, even though it appears on a separate sheet of the international application in accordance with PCT Rule 11.4(a). Thus the requirement of 37 CFR 1.52(b) that the abstract "commence on a separate sheet" does not apply to the copy of the application (pamphlet) communicated to the designated Offices by the International Bureau under PCT Article 20. Accordingly, **it is improper for the examiner of the U.S. national stage application to require the applicant to provide**

an abstract commencing on a separate sheet if the abstract does not appear on a separate sheet in the pamphlet. Unless the abstract is properly amended under the U.S. rules during national stage processing, the abstract that appears on the cover page of the pamphlet will be the abstract published by the USPTO under 35 U.S.C. 122(b) and in any U.S. patent issuing from the application.

Therefore, in the present national stage application, the filing of the original Abstract on a separate sheet is not necessary. Withdrawal of the requirement is respectfully requested.

II. Suggested Arrangement of Specification

The Examiner suggested that the specification be amended to include appropriate headers according to U.S. patent practice (Office Action, page 2). In response, applicant has inserted the appropriate headers according to U.S. patent practice in the present Amendment. Applicant believes that the present Amendment places the present application in conformity with U.S. patent practice.

III. Requirement for corrected drawings

The Examiner required that new drawings be submitted because (1) the submitted drawings had markings on them not pertinent to this application (e.g. "PCT/FI99/00562"); and (2) the boxes of the drawings "should be labeled with words instead of just numbers" (Office Action, page 3). In response, applicant has prepared replacement sheets with new drawings having word legends and not having the "not pertinent" markings; these drawings have been submitted in the present Amendment. In some cases, well-known acronyms have been used in the later drawings, after the objects have already been named (BS = Base Station; BSC = Base Station Controller). In other cases, if a reference numeral has been associated with a label (e.g., "Base station" with "92" in FIG. 2), the label (e.g., "Base station") was not reproduced next to every instance of the reference numeral (e.g., "92"). Withdrawal of the requirement is respectfully requested.

IV. The "group of patents" placed in the application file

The Examiner referred to a "group of patents" that had been placed in the application file, but did not have a corresponding Information Disclosure Statement, so they were not considered. Because the references listed did not appear to be mentioned in the present application, Michael

Stuart, an attorney representing applicant, called the Examiner in order to find out more concerning this "group of patents". In that telephone conversation, the Examiner indicated that, although he no longer had the file in his office, the Examiner remembered a small pile of prior art references had been placed in the application file. The Examiner believed that those references were misfiled by U.S. Patent Office personnel, and further suggested that we include in our response to the Office Action a statement that we do not understand his reference to these "group of patents and other literature" and that the Examiner has already acknowledged that he has considered the prior art references filed in the Information Disclosure Statement accompanying the original national stage application papers.

V. Objection to Claims 19 and 20 for having improper antecedent basis

The Examiner objected to dependent Claims 19 and 20 because they referred back to Claim 12, rather than Claim 13. In response, Claims 19 and 20 have been amended to depend from independent Claim 13 in the present Amendment. Withdrawal of the objection is respectfully requested.

VI. Rejection of all pending claims as obvious under §103(a) over *Widegren* and *Veloso*

The Examiner rejected independent Claims 1 and 13, as well as Claims 2-12 and 14-20 dependent thereon, under 35 USC §103(a) as unpatentable over *Widegren* in view of *Veloso*. Applicant respectfully disagrees: for at least the reasons below, the combination of *Widegren* and *Veloso* neither teaches nor suggests the invention claimed in independent Claims 1 and 13 of the present application.

Widegren is directed to a "wireless office gateway (WO gateway)" which is integrated into both a private telephony network (PTN) and a public land mobile network (PLMN) (lines 10-30, page 3, *Widegren*). As seen in FIG. 1 of *Widegren*, this "WO Gateway 124" is part of a "wireless office system 142" inside PLMN 102 (line 36 of page 6 to line 1 of page 7, *Widegren*). The WO Gateway 124 is connected to (i) a public cellular telephone system 140 that is also part of PLMN 102, (ii) "radio access network (RAN) 126" within the wireless office system 142, and

(iii) a "private fixed telephony network (PTN) 108" (line 11 of page 6 to line 21 of page 7, *Widegren*). In essence, WO Gateway 124 allows mobile terminals in RAN 126 inside wireless office system 142 to act as if they were "extensions" within PTN 108 (line 22 of page 7 to line 2 of page 9, *Widegren*). However, WO Gateway 124 does not let subscribers of the public cellular system 140 use subscriber apparatus in either RAN 126 or PTN 108 as if the subscriber apparatus was a mobile terminal 114 in public cellular system 140.

On the other hand, *Veloso*, like the present invention, is directed to providing users of a subscriber apparatus with the same services as the users of a mobile network. As is stated in the Background section of the present application (lines 6-20, page 1, present application) in reference to the European application corresponding to *Veloso*:

A prior-art solution is disclosed in patent EP-779 757. Said document discloses a solution in which the users of a fixed telephone network are offered an arrangement where the users of fixed subscriber apparatus can obtain the same services as the users of a mobile network. The patent discloses a method in which a SIM card can be placed in a fixed subscriber apparatus. By means of the SIM card the fixed subscriber apparatus can be connected to a mobile switching center whereby the subscriber's subscriber data can be stored in a visitor location register.

However, the invention disclosed in said EP-779 757 has some drawbacks. In the solution according to the invention disclosed in EP-779 757, the user has to acquire a new subscriber apparatus in order to have access to the mobile network services.

This is due to the fact that the access to the mobile network services is in said invention based on the presence of a SIM card in the subscriber apparatus. The cost of new subscriber equipment will be paid direct by the end user. Moreover, in the arrangement disclosed in said publication only fixed subscriber apparatus can be attached to the mobile network.

Veloso discloses an arrangement where a SIM card containing subscriber data is inserted into the subscriber apparatus of the user in order to upload the user's subscriber data to the VLR of the local mobile switching center (MSC) (see, e.g., FIG. 1 and accompanying description, *Veloso*). In other words, the subscriber data is literally inserted into the subscriber apparatus and then transmitted via landline to a network element of a mobile telephone system.

By contrast, amended independent Claim 1 of the present application recites a "method for

connecting a subscriber system comprising a subscriber apparatus of a user to a host mobile network" wherein the user also has "a mobile communication means ... on the host mobile network". In order to connect the subscriber system and the host mobile network, the method of amended Claim 1 stores "subscriber data" (which corresponds to information concerning the user's subscriber apparatus on the subscriber network) in a network element which acts as an interface between the subscriber system and the host mobile network. In this way, subscriber data does not need to be inserted into the subscriber apparatus in the form of, for example, a SIM card, as is done in *Veloso*. In fact, using the invention claimed in amended Claim 1, the subscriber apparatus need not be altered in any way in order to interact with the host mobile network.

The step of "storing, in a network element connected to the host mobile network, subscriber data corresponding to information concerning the subscriber apparatus of the user of the subscriber system, wherein the network element associates the subscriber apparatus of the user with a mobile communication means of the user on the host mobile network" as recited in amended independent Claim 1 is neither taught nor suggested by *Veloso*, *Widegren*, or their combination. As noted above, *Veloso* neither teaches nor suggests storing subscriber data in a network element. Moreover, *Veloso* neither teaches nor suggests a network element which associates the user's subscriber apparatus with the user's mobile communication means on the host mobile network.

As noted by the Examiner, the WO Gateway of *Widegren* is "allocate[s] a number series to each of the CMTs", i.e., the WO Gateway gives a phone number to each of the mobile terminals in the wireless office system 142 (lines 29-31, page 7, *Widegren*). Furthermore, each mobile terminal in the wireless office system 142 has a "personal number (PN)" which "is equivalent" to the extension numbers used for local calls within PTN 108 (lines 34-35, page 7, *Widegren*). In other words, the phone numbers of the "FTs" within PTN 108 and the "CMTs" within wireless office system 142 will have the same format or appearance. However, *Widegren* neither teaches nor suggests that the WO Gateway associates data about a mobile terminal ("CMT") of a particular user with a particular subscriber apparatus ("FT") of that particular user or vice-versa, as is recited in amended Claim 1.

In short, none of *Veloso*, *Widegren*, or their combination teaches the step of "storing, in a

network element connected to the host mobile network, subscriber data corresponding to information concerning the subscriber apparatus of the user of the subscriber system, wherein the network element associates the subscriber apparatus of the user with a mobile communication means of the user on the host mobile network" as recited in amended Claim 1. Furthermore, none of *Veloso*, *Widegren*, or their combination teaches the step of "connecting signals of said subscriber system to the host mobile network and signals of the host mobile network to said subscriber system based on said stored subscriber data" as is recited in amended Claim 1.

Furthermore, even though it has already been shown above that the combination of *Widegren* and *Veloso* neither teaches nor suggests the invention claimed in amended Claim 1, it should also be noted that the combining of *Widegren* and *Veloso* in order to make a §103 rejection is improper, i.e., the Examiner has not made a *prima facie* case of obviousness.

In order to make a *prima facie* case of obviousness, a teaching, suggestion, or incentive to combine the references in order to teach the claimed invention, must be found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Geiger*, 2 USPQ 2d 1276, 1278 (Fed. Cir. 1987). However, the teaching or suggestion to make the claimed combination must be found in the prior art, not in applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

In the present case, *Widegren* is directed to integrating a "private fixed telephony network (PTN) 108" and a private wireless office system of the same corporate entity, as was described above. *Veloso* is directed to providing users of fixed subscriber apparatus with the same services as users of a mobile network by allowing the fixed subscriber apparatus to read SIM cards. It is not clear what would motivate or suggest combining these two references to one of ordinary skill in the art.

"When the incentive to combine the teachings is not readily apparent, it is the duty of the Examiner to explain why the combination of the reference teachings is proper ... Absent such reasons or incentives, the teachings of the references are not combinable" (*Ex Parte Skinner*, 2 USPQ 2d 1788 (B.P.A.I. 1987)). The Examiner's explanation of the motivation to combine these two references is that "[i]t would have been obvious to one of ordinary skill at the time the invention to modify *Widegren*, such that SIM card data can be stored by the element/gateway, to provide

support to any/all phone [*sic*] that use SIM cards and for central storage of SIM data" (Office Action, page 5, lines 19-21).

To the extent that the reasoning in the above passage from the Office Action is understood, the Examiner appears to use the desirability of the advantages of the present invention in order to provide a motivation for combining *Widegren* and *Veloso*. In other words, the Examiner appears to be engaged in impermissible "hindsight reconstruction", where individual elements from disparate pieces of the prior art are combined in order to create the system and/or method claimed in the present invention. *In re Fritch*, 972 F.2d 1260, 23 USPQ 2d 1780 (Fed. Cir. 1992) ("The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. [The cited references] fail to suggest any motivation for, or desirability of, the changes espoused by the Examiner and endorsed by the board. ... Here the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention." *Id.*)

Thus, the Examiner has failed to establish a *prima facie* case of obviousness, because there is no motivation or suggestion for making the combination of *Widegren* and *Veloso*, except for the desirability of the advantages provided by the applicant's present application. At least because impermissible hindsight was used in making the §103 rejection of independent Claim 1 of the present application based on the combination of *Widegren* and *Veloso*, the §103 rejection of independent Claim 1 is invalid.

In summary of the above arguments, presently pending independent Claim 1 is in condition for allowance for at least two reasons: (1) there is no suggestion, motivation, or incentive to combine *Widegren* with *Veloso*, thus no §103 rejection of Claim 1 may rely on such a combination; and (2) even when improperly combined, the improper combination of *Widegren* and *Veloso* neither teaches nor suggests the invention claimed in independent Claim 1 of the present application. The

above arguments apply equally to amended independent Claim 13 of the present invention. Withdrawal of the rejection of independent Claims 1 and 13 is respectfully requested.

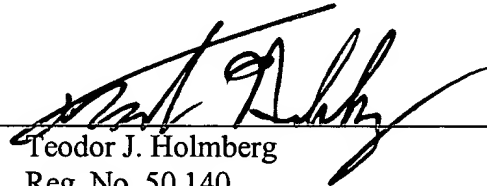
At least through their dependence on independent Claims and 13, which are believed to be in condition for allowance, dependent Claims 2-12 and 14-20 are also believed to be in condition for allowance. Withdrawal of their rejection is respectfully requested.

At least on the basis of the foregoing amendments and arguments, applicant believes all of the pending claims in the present application are in condition for allowance, which is respectfully requested.

Respectfully submitted,

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